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EXAMINER

DAVIS, ZACHARY A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2137

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/705,964

Applicant(s)

HAJMIRAGHA ET AL.

Examiner

Zachary A Davis

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. An amendment was filed on 09 August 2004. Claims 1, 3, 5, and 7 have been amended. No claims have been added or canceled. Claims 1-7 are currently pending in the present application.

Oath/Declaration

2. The objection to the oath or declaration is withdrawn in light of Applicant's comments.

Drawings

3. The objection to the drawings as failing to comply with 37 CFR 1.84(p)(5) is withdrawn in light of the amendment to the specification.

Specification

4. The objection to the disclosure for informalities is withdrawn in light of the amendments to the specification.

Claim Objections

5. The objections to Claims 1, 3, 5, and 7 for informalities are withdrawn in light of the amendments to those claims. Claim 4 is objected to below for informalities although the claim remains as originally filed. The Examiner apologizes for inadvertently omitting this objection in the previous Office action.

6. Claim 4 is objected to because of the following informalities: The claim recites the limitation "blocks text" in line 2 of the claim. It appears that this is intended to read "blocks of text". Appropriate correction is required.

Response to Arguments

7. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. The rejections of Claims 3-6 under 35 U.S.C. 112, second paragraph, as being indefinite are withdrawn in light of the amendments to the claims.

10. Regarding Claims 1, 2, and 7, the majority of the grounds for rejection under 35 U.S.C. 112, second paragraph, have been addressed by the amendments to the claims. However, as detailed below, remaining limitations in those claims still raise an issue of indefiniteness.

11. Claims 1, 2, and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, Claim 1 recites the limitation “storing information of the users associated with the assigned blocks of text of a registered document and digital signature certificates for preregistered users, digital signatures of registered documents, and the users’ selections”. It is not clear whether it is information of the digital signature certificates that is stored or if it is the digital signature certificates themselves that are being stored. If the latter is intended, the Examiner recommends amending the claim to read “storing information of the users associated with the assigned blocks of text of a registered document, digital signature certificates for preregistered users, digital signatures of registered documents, and the users’ selections”. This second interpretation has been assumed in considering the prior art.

Similarly, Claim 7 recites the limitation “storing information of the users associated with the assigned blocks of text of a registered document and digital signature certificates for preregistered users, digital signatures of registered documents, and a user’s selection”. Again, it is not clear whether it is information of the digital

signature certificates that is stored or if it is the digital signature certificates themselves that are stored.

Claim 2 is rejected due to its dependence on rejected Claim 1.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al, US Patent 6671805, in view of Padawer et al, US Patent 5220675.

In reference to Claim 1, Brown discloses a document signing system including a plurality of remotely located computer-based systems (Figure 5, elements 502; column 14, line 65-column 15, line 4), each including a user interface component for displaying an electronic document (column 9, lines 43-45) and identifying blocks of text for at least one signature task (column 8, lines 35-37), a processing component for uniquely identifying blocks of text (column 8, lines 35-37), and a browser component including an assigning component for assigning users to the uniquely identified blocks of text (column 8, lines 5-7) and a signing component for reviewing the assigned blocks of text (column 13, lines 13-19) and digitally signing the document (column 13, lines 22-24) and selecting an acceptance option (column 13, lines 22-27). Brown further discloses

that the system includes a document computer-based system coupled to the remote systems over a network (Figure 5, element 506; column 17, lines 16-18) including a registering component including a component for identifying blocks of text (column 11, lines 65-67) and a component for verifying the correctness of blocks of text (column 22, lines 12-22); a storing component for storing users, digital signatures, and users' selections (column 9, lines 24-26 and 37-42); and a retrieval component for retrieving documents with signature tasks, stored digital signatures, and users' selections (column 10, lines 1-5; column 18, lines 59-63). However, although Brown discloses selecting an acceptance option and that this may be performed in a number of ways (column 13, lines 22-27), Brown does not explicitly disclose selecting a decline option.

Padawer discloses a system in which a user is offered to accept or decline changes in a document (see Figure 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brown to include a decline option in addition to the acceptance option, in order to allow the system to be customized based on the needs of the individual users (column 1, lines 12-17).

In reference to Claim 2, Brown further discloses assigning a completion deadline (column 19, line 61-column 20, line 5, where the signer is notified if the signing has not been completed by a certain time).

Claims 3 and 4 are method claims corresponding substantially to system claims 1 and 2, respectively, and are rejected by a similar rationale.

In reference to Claim 5, Brown discloses a document signing system including a user interface component for displaying an electronic document (column 9, lines 43-45) and identifying blocks of text for at least one signature task (column 8, lines 35-37), a processing component for uniquely identifying blocks of text (column 8, lines 35-37), and a browser component including an assigning component for assigning users to uniquely identified blocks of text (column 8, lines 5-7) and a signing component for reviewing the assigned blocks of text (column 13, lines 13-19) and digitally signing the document (column 13, lines 22-24) and selecting an acceptance option (column 13, lines 22-27). However, although Brown discloses that selecting the acceptance option may be performed in a number of ways (column 13, lines 22-27), Brown does not explicitly disclose selecting a decline option.

Padawer discloses a system in which a user is offered to accept or decline changes in a document (see Figure 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brown to include a decline option in addition to the acceptance option, in order to allow the system to be customized based on the needs of the individual users (column 1, lines 12-17).

In reference to Claim 6, Brown further discloses assigning a completion deadline (column 19, line 61-column 20, line 5, where the signer is notified if the signing has not been completed by a certain time).

In reference to Claim 7, Brown discloses a document signing system including a registering component including a component for identifying blocks of text (column 11, lines 65-67) and a component for verifying the correctness of blocks of text (column 22, lines 12-22); a storing component for storing users, digital signatures, and users' selections (column 9, lines 24-26 and 37-42); and a retrieval component for retrieving documents with signature tasks, stored digital signatures, and users' selections (column 10, lines 1-5; column 18, lines 59-63). However, although Brown discloses that a selection may be an acceptance option and that the selection may be performed in a number of ways (column 13, lines 22-27), Brown does not explicitly disclose that the selection is made between an acceptance option and a decline option.

Padawer discloses a system in which a user is offered to accept or decline changes in a document (see Figure 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brown to include a selection between the acceptance option and a decline option, in order to allow the system to be customized based on the needs of the individual users (column 1, lines 12-17).

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A Davis whose telephone number is (571) 272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Andrew Caldwell
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